

No. 18634

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

LEAR SIEGLER, INC., a corporation,

Appellant,

vs.

JOHN S. ADKINS,

Appellee.

On Appeal From the United States District Court for the
Southern District of California, Central Division.

Appellant's Opening Brief on Appeal and on Request
for Writ of Mandamus.

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for Writ of Mandamus.

Jurisdictional Statement.

This appeal is in an action where the jurisdiction of the United States District Court for the Southern District of California, Central Division, was based on 28 United States Code, Section 1338, relating to patent causes, on 28 United States Code, Section 1331, relating to the amount in controversy, and on 28 United States Code, Section 2201, relating to declaratory judgments.

The jurisdiction of this Court is based on 28 United States Code, Section 1292, and on 28 United States Code, Section 1651.

The complaint [Tr. 2] in the District Court proceedings sets forth the basis for the District Court's jurisdiction. The Order Relating to Stay of All Fur-

ther Proceedings [Tr. 88] sets forth the basis for this Court's jurisdiction under 28 United States Code, Section 1292(b). In the order the District Court stated that the order involves a controlling question of law as to which there is ground for difference of opinion and that an immediate appeal from the order may materially advance the ultimate termination of the litigation. The Order Relating to Stay of All Further Proceedings is tantamount to an injunction against further proceedings until a final determination of a state court action and thereby provides a basis for this Court's jurisdiction under 28 United States Code, Section 1292(a) also. The Order Relating to Stay of All Further Proceedings [Tr. 88] also shows the basis for this Court's jurisdiction under 28 United States Code, Section 1651, because the order stays all further proceedings in the District Court until a final determination of a state court action, whereas the jurisdiction of the District Court is exclusive of the courts of the states in patent cases under 28 United States Code, Section 1338. A writ is necessary in aid of the jurisdiction of this Court and of the District Court over patent cases.

Statement of the Case.

Appellant filed a complaint for declaratory judgment on March 1, 1963 in the United States District Court for the Southern District of California, Central Division, Civil Action No. 63-241-Y. The complaint seeks a declaratory judgment of invalidity, unenforceability, and non-infringement of United States Letters Patent 2,919,586. [Tr. 2.]

Appellee moved for a stay of all further proceedings in the declaratory judgment action because of an ac-

tion in the Superior Court of the State of California in and for the County of Los Angeles, No. 737,267. [Tr. 11.] No answer to the complaint has been filed.

On April 9, 1963 the Honorable Leon R. Yankwich entered the following order :

“IT IS ORDERED that the Motion of the Defendant to Stay all Further Proceedings herein until final adjudication in that certain action now pending between the same parties hereto in the Superior Court of the County of Los Angeles, entitled JOHN S. ADKINS, Plaintiff v. LEAR, INCORPORATED, ET AL., Defendants, being Case No. 737,267 therein, is hereby granted.

“The Court finds that this Order involves a controlling question of law as to which there is ground for difference of opinion and that an immediate appeal from this order may materially advance the ultimate termination of this litigation.” [Tr. 88-89.]

The complaint in the Superior Court action alleges breach of contract as a first cause of action and misappropriation as a second cause of action. [Tr. 20.] The Superior Court action was filed on January 5, 1960, and is presently in the discovery stage.

The complaint in the Superior Court action alleges that the parties to the present suit entered into a license agreement concerning certain products and developments. [Tr. 21.] Said license agreement concerned an issued United States Letters Patent No. 2,542,975 and an application for patents covering the inventions of certain exhibits to the agreement to the extent that such inventions are patented or patentable to appellee. [Tr. 27-30.] Patent Application Serial

No. 410,237 is one of said exhibits, and it issued as United States Letters Patent No. 2,919,586 on January 5, 1960. [Tr. 59-60.] The other issued patent No. 2,542,975 is not in controversy.

The license agreement provided in Section 2(a) that appellant shall have the right on ninety days' prior written notice to terminate any one or more of the licenses which were granted under the agreement. [Tr. 30.] The license agreement provided in Section 6 that in the event the U. S. Patent Office refuses to issue a patent on the substantial claims of the patent applications, such as patent application Serial No. 410,237, then appellant may at its option forthwith terminate the entire license agreement and no further royalties shall thereupon be payable under the license agreement. [Tr. 37.]

Appellant gave written notice of termination of the license agreement under Sections 2(a) and 6 of the agreement. The written notice was on April 8, 1959. [Tr. 66.]

Appellee alleges that appellant continues to manufacture and sell products for which royalties are required under said license agreement [Tr. 23], and this is the basis for appellee's alleged cause of action in the state court for breach of contract. [Tr. 20-23.]

Appellee's alleged cause of action for misappropriation is based upon the alleged appropriation of his ideas, discoveries, and inventions by appellant. [Tr. 23-25.]

In view of appellant's termination of the license agreement exactly in accordance with the express provisions of the license agreement, appellant asserts that

there is no possible cause of action for breach of contract with respect to appellant's activities subsequent to the termination of the license agreement. [Tr. 60-61.] Appellant also asserts that there is no possible cause of action for misappropriation. [Tr. 41, 87.]

Accordingly, appellant asserts that any rights which appellee may have must be based upon statutory patent rights.

Appellee asserts that most or all of the issues in the present action will be resolved in the state court action [Tr. 70], and that infringement of Patent No. 2,919,586 will be in issue only if the state court action is unsuccessful. [Tr. 18.]

Appellant asserts that most or all of the issues in the present action will not be resolved in the state court action, that the state court proceedings probably will run for several years, and that a prompt adjudication of validity, infringement and enforceability of Patent No. 2,919,586 is necessary to ascertain the rights of the parties under the patent laws and to protect appellant from a long delay in clarifying these rights. [Tr. 61, 84-87.]

Appellant also asserts that adjudication of validity, infringement and enforceability of Patent No. 2,919,586 is under the original jurisdiction of the District Court to the exclusion of the state court, and that this Court should direct the District Court to try these issues in order to retain its exclusive jurisdiction over patent cases. This Court should act in order to protect its potential appellate jurisdiction.

Specification of Errors.

1. The District Court erred as a matter of law in granting an order to stay all further proceedings until final adjudication of another action now pending between the parties hereto in the Superior Court of the County of Los Angeles.
2. The District Court abused its discretion in granting an order to stay all further proceedings until final adjudication of another action now pending between the parties hereto in the Superior Court of the County of Los Angeles.

Summary of Argument.

The stay of all further proceedings in this action is in error as a matter of law because this action pertains to matters in which the District Court has original jurisdiction and such jurisdiction is exclusive of the state court. The District Court should conduct the trial of this action promptly in order to protect its own jurisdiction.

The stay of all further proceedings in this action is in error or constitutes an abuse of discretion by the District Court because the pending state court action cannot resolve all of the issues of the present case.

The stay by the District Court constitutes an interlocutory decision and order over which this Court has jurisdiction. The District Court was of the opinion that the order involves a controlling question of law as to which there is substantial ground for difference of opinion and that an immediate appeal from the order may materially advance the ultimate termination of the litigation.

The stay by the District Court constitutes an abuse of discretion by the District Court over which this Court has jurisdiction.

ARGUMENT.

I.

The District Court Has Exclusive Jurisdiction Over Patent Cases and Cannot Properly Stay the Present Patent Case Until Final Adjudication of the State Court Action.

With reference to the jurisdiction of the courts over patent cases, the patent laws provide:

28 U. S. C. 1338(a). "The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, copyrights and trade-marks. Such jurisdiction shall be exclusive of the courts of the states in patent and copyright cases."

The present action is a civil action arising under an Act of Congress relating to patents. The present action seeks an adjudication of invalidity and non-infringement of the U. S. Patent No. 2,919,586 and also seeks an adjudication that the patent is unenforceable. The validity of the patent is subject to the conditions set forth in 35 U. S. C. 100-188. Infringement of the patent is subject to the provisions of 35 U. S. C. 271-293. Enforceability of the patent is subject to the provisions of 35 U. S. C. to the provisions of the antitrust laws 15 U. S. C. 1-15, and to the provisions of the common law.

The Patent Office was established to administer the patent laws enacted by Congress in accordance with Article I, Section 8 of the Constitution.

The *Rules of Practice of the United States Patent Office in Patent Cases* state:

"56. Improper applications. Any application signed or sworn to in blank, or without actual in-

spection by the applicant, and any application altered or partly filled in after being signed or sworn to, and also any application fraudulently filed or in connection with which any fraud is practiced or attempted on the Patent Office, may be stricken from the files.”

The present action involves all of the Acts of Congress set forth above. In accordance with the provisions of 28 U. S. C. 1338(a) the District Court has original jurisdiction and such jurisdiction is exclusive of the state courts.

The present action also involves the declaratory judgment statutes. The primary statute states:

28 U. S. C. 2201. “In a case of actual controversy within its jurisdiction, except with respect to Federal taxes, any court of the United States, upon the filing of an appropriate pleading, may declare the rights and other legal relations of any interested party seeking such declaration, whether or not further relief is or could be sought. Any such declaration shall have the force and effect of a final judgment or decree and shall be reviewable as such.”

Obviously there is an actual controversy concerning U. S. Patent No. 2,919,586. Appellee asserts that the validity and the scope of the patent are in controversy. [Tr. 48.] Moreover, the complaint in the state court action and the supporting license agreement place the validity and scope of the patent in issue because the license agreement defines inventions as those that are patented or patentable [Tr. 29] and the license agree-

ment grants rights under claims which have been patented or which will be patentable. [Tr. 30.]

The scope of the patent is determinative of whether or not there is infringement. The statutory provision defines infringement as follows:

35 U. S. C. 271(a). "Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent."

Infringement is determined by the claims of the patent interpreted in the light of the description of the invention in the specification of the patent. *Schmitzer et al. v. California Corrugated Culvert Co. et al.* (9th Cir., 1944), 140 F. 2d 275. *Fulton Co. v. Powers Regulator Co.* (2nd Cir., 1920), 263 Fed. 578. *General Motors Corporation v. Kesling* (8th Cir., 1947), 164 F. 2d 824.

Where the nature of the patented invention and the alleged infringing device are clear, the question of infringement is a question of law. *Kwikset Locks, Inc. v. Hillgren* (9th Cir., 1954), 210 F. 2d 483.

In addition, appellee has stated in the pleadings that he will charge appellant with infringement if the state court action is unsuccessful. [Tr. 18.] This is a threat to bring infringement proceedings on the patent, and as such places the matter in controversy within the meaning of the declaratory judgment statute, 28 U. S. C. 2201; *Crowell v. Baker Oil Tools, Inc. et al.* (9th Cir. 1944), 143 F. 2d 1003.

In *Girdler Corporation v. E. I. Du Pont de Nemours & Co.* (D. C. Del. 1944), 56 F. Supp. 871, 875, the court stated:

“The mere assertion of adverse rights evidences the existence of a justiciable controversy between the owner of the patent and the declaratory judgment plaintiff.”

In *Grip Nut Co v. Sharp* (7th Cir. 1941), 124 F. 2d 814, 815 the court stated:

“Today, the alleged infringer once he is threatened by a patentee, has a remedy by complaint for a Declaratory Judgment. Now, . . . ‘the controversy between the parties as to whether a patent is valid, and whether infringement exists is in either instance essentially one arising under the patent laws of the United States.’ ”

Thus, there is an actual controversy as to the validity, scope, infringement, and enforceability of the patent in question. This controversy probably will take several years to resolve if the proceedings in the District Court are stayed pending a final adjudication in the state court action. [Tr. 84.] The controversy involves a large sum of money, and a long delay in resolving the controversy would place an intolerable burden on appellant. [Tr. 87.] The controversy involves a matter over which the District Court has original jurisdiction exclusive of the state court. Hence the District Court should not stay its proceedings, but rather, it should act promptly in order to protect its jurisdiction.

Very similar issues concerning the administration and enforcement of Acts of Congress were presented

in *Lyons et al. v. Westinghouse Electric Corporation* (2nd Cir. 1955), 222 F. 2d 184.

The *Lyons* case involved the antitrust acts and the stay of a District Court action pending final judgment in a state court action between the same parties.

The court summarized the issue as follows:

“Thus the inquiry comes down to whether, when Congress gave exclusive jurisdiction to the district court over wrongs committed under the Anti-Trust Acts, it only meant that the ‘person who shall be injured’ must sue in the district court to recover damages; or whether it also meant that the district court must have unfettered power to decide the claim, regardless of the findings of any other courts, even when these were essential to the decision of actions over which their jurisdiction was unquestioned.” 222 F. 2d 184, 188.

The court decided this issue as follows:

“In the case at bar it appears to us that the grant to the district courts of exclusive jurisdiction over the action for treble damages should be taken to imply an immunity of their decisions from any prejudgment elsewhere; at least on occasions, like those at bar, where the putative estoppel includes the whole nexus of facts that makes up the wrong. The remedy provided is not solely civil; two thirds of the recovery is not remedial and inevitably presupposes a punitive purpose. It is like a *qui tam* action, except that the plaintiff keeps all the penalty, instead of sharing it with the sovereign. There are sound reasons for assuming that such recovery should not be subject

to the determinations of state courts. It was part of the effort to prevent monopoly and restraints of commerce; and it was natural to wish it to be uniformly administered, being national in scope. Relief by certiorari would still exist, it is true; but that is a remedy burdensome to litigants and to the Supreme Court, already charged with enough. Obviously, an administration of the Acts, at once effective and uniform, would best be accomplished by an untrammelled jurisdiction of the federal courts.” 222 F. 2d 184, 189.

This Court recently decided a very similar issue to that presented by the present case in *Mach-Tronics, Incorporated v. The Honorable Alfonso J. Zirpoli* (9th Cir. 1963), 316 F. 2d 820.

The *Mach-Tronics* case also involved the administration and enforcement of Acts of Congress—the anti-trust laws. The propriety of a stay of a District Court action until completion of all proceedings in a state court action, or “until further order of this court” was under consideration.

The stay in the present action is even more restrictive because it is to stand until final adjudication in the state court without any proviso for further order of the court.

This Court held that the stay in the *Mach-Tronics* case was improper because the federal court had exclusive jurisdiction. This Court considered whether or not the judgment of the state court would operate as an estoppel and stated:

“But let us suppose that such a determination in the state court would operate as an estoppel. That

in our view would constitute an additional reason for the respondent court to proceed without delay with the hearing and determination of the case presented by petitioner's complaint." 316 F. 2d 820, 832-833.

* * * * *

"We have noted here the congressional policy to entrust to the federal district courts the determination of questions of fact and law in treble damage suits brought pursuant to § 15. We think it to be a part of our function to see that this policy, entrusted to the courts, is not frustrated or abandoned." 316 F. 2d 820, 834.

In *Propper v. Clark* (1948), 337 U. S. 472, the Supreme Court considered another Act of Congress—the Trading with the Enemy Act of 1917—and related actions in a state court and in a Federal court. The court considered matters involving both the Act of Congress and state laws and stated:

"Furthermore, as the state court could reasonably require complete adjudication of the controversy, the District Court would perhaps be compelled to stay proceedings in the state court to protect its own jurisdiction. 28 USC 1948 ed § 2283. Otherwise in sending a fragment of the litigation to a state court, the federal court might find itself blocked by res judicata with the result that the entire federal controversy would be ousted from the federal courts where it was placed by Congress." 337 U. S. 472, 491-492.

* * * * *

“We reject the suggestion that a decision in this case in the federal courts should be delayed until the courts of New York have settled the issue of state law.” 337 U. S. 472, 492.

The present case involves an Act of Congress like the *Lyons*, *Mach-Tronics* and *Propper* cases. The present case involves the administration and enforcement of laws over which the Federal courts have exclusive jurisdiction, just as in the *Lyons* and *Mach-Tronics* cases. The present case involves a stay until final adjudication in the state court without any provision for requesting the District Court to reopen the case and hence is a more flagrant violation than was the *Mach-Tronics* case.

The stay should be removed in the present case just as it was in the *Lyons*, *Mach-Tronics* and *Propper* cases because an Act of Congress is controlling and because exclusive jurisdiction is in the District Court.

II.

The Issues in This Action Are Governed Primarily by Acts of Congress and There Are No Controlling Issues of State Law.

The patent laws were enacted by Congress and the Patent Office was established to administer the patent laws in accordance with Article I, Section 8 of the Constitution.

The present action contests the validity of U. S. Patent No. 2,919,586 [Tr. 4], it contests infringement of the patent [Tr. 7], and it contests the enforceability of the patent because of the antitrust laws. [Tr. 8.] These issues are governed by Acts of Congress and not by state laws.

The validity and enforceability of the patent in question affects the public of the United States because the patent was issued by the United States Government and has nation-wide effect. Hence, validity and enforceability are primarily federal questions.

Appellee asserts that appellant is estopped to contest the patent in question because of a license agreement between the parties. [Tr. 70-72.]

However, the license agreement related to the application for the patent in question and it was terminated by appellant before the patent issued and before any of the patent claims in issue were allowed by the Patent Office. [Tr. 66.]

Appellant complied with the express provisions in the agreement and hence the agreement was terminated. There can be no estoppel of any kind and there can be no implied obligation to cease manufacturing.

“We recognize, of course, the rule by which a patent licensee may be estopped during the term of the license to dispute the validity of the patent, but we are of the view that it has no application where the licensee effects a valid cancellation of the license agreement, as was done here.”

Michle Printing Press & Mfg. Co. v. Publication Corporation (7th Cir. 1948), 166 F. 2d 615, 618.

“That being out of the case, we can find no ground on which to restrain the manufacture and sale by the appellants of the articles mentioned. It may expose the appellant to a suit for infringement, but that, as we have said, is foreign to the purpose of the present suit. Aside from the patent, there

is nothing to prevent the appellant from selling the same kind of goods as it sold during the term of the contract.”

Stimpson Computing Scale Co. v. W. F. Stimpson Co. (6th Cir. 1900), 104 Fed. 893, 897.

The issues concerning estoppel and implied obligations do not involve any particular state law or state constitutional provision. These issues involve common law and equitable principles. In other words, there are no controlling issues of state law. The primary issues are governed by federal law, and hence the District Court should try the issues of validity, infringement and enforceability.

The whole nexus of issues pertaining to the patent in suit is involved in the federal court action, whereas only the issues of breach of contract and misappropriation are involved in the state court action.

Where there are controlling issues of state law, some courts have held it proper to stay a federal action. Such issues have involved particular state laws, state constitutional questions, state regulatory officers, real property located within a state, and the public policy of a state. However, no such issues are involved in the present case. This in itself is sufficient to justify the removal of the stay in the present case. *Mach-Tronics, Incorporated v. The Honorable Alfonso J. Zirpoli* (9th Cir. 1963), 316 F. 2d 820, 827.

III.

The Order of the District Court Is an Appealable Order.

The order of the District Court which stays all further proceedings until final adjudication of an action in the state court is tantamount to an injunction. As such it is an appealable interlocutory decision under 28 U. S. C. 1292(a). *Adrian Ettelson et al. v. Metropolitan Life Insurance Company* (1942), 317 U. S. 188.

In any event the Order is appealable under 28 U. S. C. 1292(b) because the District Court stated that the order involves a controlling question of law as to which there is substantial ground for difference of opinion and that an immediate appeal from the order may materially advance the ultimate termination of the litigation. The question of law is whether the District Court should act to protect its jurisdiction over a patent case or whether it should await the outcome of a state court action which might create a *res judicata* situation.

IV.

This Is an Exceptional Case Warranting a Writ of Mandate in Aid of the Jurisdiction of This Court and of the District Court.

The Patent Laws provide that the District Court has original jurisdiction over patent cases to the exclusion of state courts. 35 U. S. C. 1338.

The state court action now pending between the parties to this appeal involves United States Patent No. 2,919,586 in a direct manner. [Tr. 59.] Appellee contends that the state court action probably will determine all of the issues concerning this patent

or will result in this action, which is the subject of this appeal, becoming moot. [Tr. 49.]

Thus appellee is asserting that the state court action will resolve or render moot the issues of validity, infringement and enforceability of U. S. Patent No. 2,919,586—which matters are under the original jurisdiction of the District Court to the exclusion of state courts.

In other words, appellee is seeking to deprive this Court of its potential appellate jurisdiction over a patent case, and appellee is seeking to deprive the District Court of its original and exclusive jurisdiction of the patent case.

A Court of Appeals is empowered to direct a District Court to vacate a stay order which may have the effect of frustrating a potential appellate jurisdiction in the Court of Appeals to adjudicate the question involved. *McClellan v. Carland* (1910), 217 U. S. 268.

The District Court already has jurisdiction over the action.

“. . . mandamus in the United States courts is an ancillary remedy to be utilized only in the exercise of a jurisdiction already acquired. . . . the New Rules of Civil Procedure, 28 U.S.C.A. . . . enable the courts of the United States to grant relief upon a showing of facts entitling a plaintiff to relief even though he does not pray the precise relief to which he is entitled.” *C.D. Mathews Estate, Inc. v. Olive Branch Drainage* (7th Cir. 1950), 185 F. 2d 53, 54, 55.

With reference to writs of mandamus, this Court in *Hartley Pen Company v. United States District Court* (9th Cir. 1961), 287 F. 2d 324 stated:

“In our view the remedy is available in an ordinary case within our jurisdiction if ordinary remedies are inadequate and there are present exceptional and extraordinary circumstances which require the issuance of an extraordinary writ to prevent a grave miscarriage of justice.”

This Court also stated in *Butler v. Judge of United States District Court* (9th Cir. 1941), 116 F. 2d 1013 that:

“The pendency of the same cause of action in a state court between the same parties is ordinarily not a ground for abatement of the action in the federal court.”

The present case presents extraordinary circumstances in that the stay of proceedings in the District Court may permit a state court to adjudicate substantial issues concerning the validity, infringement and enforceability of U. S. Patent 2,919,586. The stay deprives the District Court of its original and exclusive jurisdiction and it deprives this Court of its potential appellate jurisdiction.

If the remedy afforded by appeal under 28 U. S. C. 1292 should be improper or inadequate, it is requested that this Court issue a writ of mandate under the liberal interpretation of the Rules of Judicial Procedure —28 U. S. C.

V.

Conclusion.

The stay of all further proceedings in the District Court should be removed in order to protect the jurisdiction of the District Court over patent cases and in order to protect this Court's potential appellate jurisdiction.

The stay of all further proceedings in the District Court should be removed because the issues involved in the proceedings are governed primarily by Acts of Congress and there are no controlling issues of state law.

The stay of all further proceedings in the District Court should be removed in order to resolve the controversy concerning U. S. Patent No. 2,919,586 at an early date. The validity and enforceability of this patent affect the general public of the United States as well as the parties hereto.

The District Court erred as a matter of law and abused its discretion in ordering a stay of all further proceedings until final adjudication of a state court action.

This Court is requested to correct the error of law and the abuse of discretion by directing the District Court to remove the stay.

Respectfully submitted,

CHRISTIE, PARKER & HALE,
By C. RUSSELL HALE,
EDWIN L. HARTZ,
Attorneys for Appellant.

Certificate.

I certify that in connection with the preparation of this brief I have examined Rules 18 and 19 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

C. RUSSELL HALE

